

Remarks/Arguments:

Claims 46-70, previously presented, and claims 70 and 71, presented hereby, are pending.

Claim 46-70 stand rejected under 35 USC 103(a) as allegedly being unpatentable base don the combined teachings of US 4835002 (Wolf) and US4944956 (Brun). Reconsideration is requested.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). A "ground of rejection is simply inadequate on its face . . . [when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). A property of the claimed invention that must be taken into consideration when comparing the claims against the prior art, whether or not it is not recited in claims 1-8. *In re Estes*, 164 USPQ 519 (CCPA). *See, In re Papesch*, 137 USPQ 43, 51 (CCPA 1963).

The totality of each reference's teachings must be considered when combining those teachings with the rest of the prior art. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciate of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986).

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). References taken in combination teach away when the combination would produce a "seemingly inoperative device." *In re Spinnoble*, 160 USPQ 237, 244 (CCPA 1969). A "reference teaches away if it leaves the impression that the product would not have the property sought by the applicant." 31 USPQ2d at 1132, citing with approval *In re Caldwell*, 138 USPQ 243, 245 (CCPA 1963).

The rejected claims provide an anethol-containing beverage (alcoholic or non-alcoholic) which also contains a suitable phospholipid. The claimed product is in the form of an anethol-phospholipid/aqueous micro-emulsion. The anethol-containing micro-emulsion "is clear" (claim 50), and it becomes cloudy when an acidic liquid or water is added, because the micro-emulsion is destabilized (claims 57 and 58).

Wolf teaches the production of micro-emulsions containing water and an edible-oil flavoring agent, which micro-emulsions form products – primarily beverages – that are clear, without the necessity of, first, extracting from the oil (flavoring agent) its "alcohol" insoluble components (Wolf, column 9, lines 3-13). These water-in-oil emulsions also contain a surfactant (such as lecithin) and an "alcohol" – the term being used in Wolf to cover propylene glycol, ethanol, sugars, and glycerine – propylene glycol being the preferred "alcohol." It is critical that the micro-emulsions remain stable, thermodynamically, for long periods of time (Wolf, column 2, lines 30-33). They are taught

as being particularly useful in products (e.g., carbonated beverages) "where the long term *clarity* of such products is an important selling point" (Wolf, column 8, lines 57-61, *emphasis added, see also* column 9, lines 54-57); moreover, the thus formed products are "non-ringing" when bottled – i.e., the flavoring oil does not separate out, rise to the top, and form a *ring* at the neck of the bottle (Wolf, column 9, lines 13-25).

Brun teaches a very specific alcoholic beverage, containing specific surfactants leading to an increase of anethol solubility in ethanol in order to have clear beverages able to become cloudy when water or acidic liquid is added.

According to the statement of rejection,

Wolf teaches the production of microemulsions of oil in water and alcohol. The alcohol can be ethanol (col. 4, lines 12-13). The surfactant can be those that are useful in beverages, including lecithin or hydroxylated lecithin. (Col. 4, line 48 to col. 5, line 28). In examples of 6-13, it is shown that the emulsified particles had a particle size at a higher level of the 100 to 600A (10-60 nanometers) particle size range peculiar to microemulsified particles. The beverages can be sold in "clear liquid form" (col. 9, line 54 to col. 10, line 60). Wolf does not teach the addition of anethole.

Brun teaches the production of an alcoholic beverage such as pastis that contain anethole at 2 grams/liter (col. 1, lines 9-15). It would have been obvious to include anethole, which is notoriously well-known and used in the beverage industry, as shown by Brun, in the beverages of Wolf as those in the beverage industry commonly use anethole to produce pastis.

The statement of rejection is mistaken.

As opposed to the invention provided in the rejected claims, Wolf neither teaches nor suggests providing a clear beverage concentrate that becomes cloudy when mixed with water or an acidic liquid to form the beverage that is suitable for drinking purposes. On the contrary, Wolf

unequivocally requires that the drinkable beverage remain clear, such that the micro-emulsion in the beverage remains stable – whereas, the micro-emulsion in the presently claimed invention is destabilized when mixed with water or an acidic liquid, as explained above.

It would not have been obvious to combine Wolf and Brun, as alleged in the statement of rejection, because it would destroy the invention on which Wolf is based. The ultimate micro-emulsion-containing beverage products of Wolf must remain *clear* ("clarity" is an indispensable component, as explained above). In order to maintain this "clarity", the micro-emulsions of Wolf must remain *stable* (as explained above) in the final beverage products.

Modifying Wolf according to the teachings of Brun, as alleged in the in the statement of rejection, would destroy the invention on which Wolf is based. Brun discloses an anethol-containing emulsion, which becomes cloudy when mixed with water, i.e., to form a beverage suitable for drinking. Therefore, modifying the teachings of Wolf to contain the anethol-containing micro-emulsion of Brun would destroy the "clarity" of the beverage product, on which the Wolf invention is based. Therefore, the rejection under section 103(a) based on the combined teachings of Wolf and Brun cannot be maintained, because it would render the Wolf invention "seemingly inoperative." *Sponnoble, supra*.

Applicant submits that, as opposed to Wolf, the invention of the rejected claims is directed to an ethanolic solution containing anethol without any essential (edible) oil, which solution remains clear when they are in bottles and form homogenous and stable hazes when quantities of water or acidic liquid are added. It would not have been obvious to include anethol in a concentration of 0.02

to 1%, i.e., very lower than those disclosed in Wolf, in the beverages of Wolf to produce *pastis*. Nothing in Wolf teaches suggests that the emulsions of Wolf could be modified to contain *anethol* and, thus, provide for a bottled clear concentrate that, when combined water or acidic liquid, form cloudy (bottled) beverages.

Applicant, further observes, that all working examples of Wolf appear to teach micro-emulsions containing propylene glycol as alcohol at concentrations of 25 to 80%, which are not compatible with the European law, which only authorizes concentrations limited to 0.2%.

***Request for Acknowledgment of
Foreign Priority Under 35 USC 119***

A claim to foreign priority under 35 USC 119 has been made in the inventorship declaration, of record, and the certified copy of the priority document received by the PTO (Notification of Acceptance, mailed January 20, 2000, by the PTO, and Form PCT/IB304, mailed 21 April 1999 by the International Bureau).


Accordingly, request is made that the Examiner mark the next Office Action to acknowledge, both, the claim to §119 priority and receipt of the certified copy.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By:

A handwritten signature in black ink, appearing to read "William E. Player", written over a horizontal line.

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